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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,125	03/26/2001	Masahiro Minowa	81747.0191	8629
26021 7590 01/25/2007 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER RETTA, YEHDEGA	
			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/25/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/818,125

Applicant(s)

MINOWA, MASAHIRO

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response amendment filed November 16, 2006. Claims 1-23 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeper (US 6,401,074) and further in view of Hunter et al. (US 6,650,429).

Regarding claims 1, 4-6, 12-15, Sleeper invention provides an augmented POS system that includes capabilities for real-time displaying and broadcasting of commercial information within the context of a retail transaction (see col. 1 line 50 to col. 2 line 8). *Sleeper* teaches a central computer (backroom server commonly linked via a telecommunication link to a computer system that reside in a remote home office or a remote regional office (see fig. 1 and col. 3 lines 28-55) or advertiser's computer system (see fig. 6 and col. 10 lines 1-12) providing means for distributing specific data (retailer generating a revenue by providing promotional displays to vendors of the products the retailer sells, or retailer agreeing to display promotional data about the manufacturer's of a product line) in addition to displaying the message, printing the advertisers message on a receipt of POS system, and charging advertisers fee for displaying and printing the message; a central computer integrally controlling the POS system (see col. 3 lines

11-67 col. 4 lines 28-39, col. 9 line 60 to col. 10 line 12). Sleeper does not teach providing the advertisers with placement application page. Hunter teaches server (customer interface web server) providing means for storing application page containing an advertising placement application form; means for sending the application page containing the application form to the client PC in response to a request from the client PC; receiving and storing input information containing advertising placement information (see fig. 1 and col. 2 line 66 to col. 3 line 22, col. 4 lines 3-43, col. 7 lines 25-50). Hunter teaches accessing a central station via the Internet through interface web server sending advertisement content and for scheduling and purchasing advertisement time for displaying advertisement in specific locations. Hunter teaches a second server, different from the first server, providing means for receiving and storing input information containing advertising placement information provided by the client PC in accordance with the application form (see col. 3 lines 22-30). Hunter teaches the video & still image review and input module permits a system security employee to conduct a content review to assure that all content meets the security and appropriateness standards established by the system prior to the content being read to the server 100 (see also fig. 1). Hunter also teaches enabling selection of one place name from a plurality of names of places or area, where advertisement can be placed; enabling specification of one or more conditions restricting advertising placement, specifying advertising period, specific time period, target (see col. 4 lines 5-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Sleeper's POS system with the direct ad placement of Hunter since Hunter's direct placement of advertisement would provide the vendors and manufacturers of Sleeper means for directly sending their advertisement information to be displayed and printed in locations and

times selected by them. It would also be obvious to provide means to the vendors or manufacturers of Sleeper for specifying conditions restricting advertisement placement since the advertisement of Sleeper is based on conditions agreed by the retail store and manufacturers (see col. 9 line 61 to col. 10 line 12).

Regarding claim 2, Hunter teaches means for calculating an advertising placement fee, means for storing and sending the calculated fee information to the client PC, means for confirming fee payment (see col. 4 lines 4-46, col. 6 line 62-25). Hunter teaches billing and report generation module providing reports showing calculating advertisement placement fee storing and sending the calculated fee information and payment to user. It would have been obvious to one of ordinary skill in the art at the time of the invention for one to know that the retail stores of Sleeper would charge the vendors or manufacturers a fee for displaying and printing the advertisement, in order to generate revenue by providing promotional display, as taught in Sleeper, and to inform the advertisers by providing billing system for the service provided, as taught in Hunter.

Regarding claim 3, Sleeper teaches plurality of POS system installed in plurality of branches or stores of chain store (see col. 2 lines 41-65). It is inherent for a retail system to provide the same POS system in each chain store or branches.

Regarding claim 9, Sleeper teaches selling advertising space to advertisers for displaying and printing advertisement, however does not teach specification of number of pages printed (see col. 9 line 61 to col. 10 line 12). Official notice is taken that is old and well know in advertisement to specify the number of ad prints or volume and to be charged based on the number of ads printed or displayed. Therefore, it would have been obvious to one of ordinary

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skill in the art at the time of the invention to provide a page for specifying the number of prints for those who prefer to pay fee based on the number of printed coupons, rather than based on time period, in order to make sure that advertiser is paying only for coupons that are provided to customers.

Regarding claims 16, 18, 20 and 21 Sleeper teaches receiving and storing advertisement placement information, charging fee for the placement of the advertisement, registering in the computer of a POS system, advertising information and outputting advertisement by means of a printer device, charging the advertisers for placement of the advertisement; sending specific information to the POS system; distributing by central computer connected to POS, via the Internet (see col. 3 lines 1-67, col. 6 lines 50-67, col. 8 lines 47-67, col. 9 line 60 to col. 10 line 3). Sleeper does not teach how the advertisers submit the advertisement placement information that is displayed and printed by the retailer stores (POS) and calculate an advertisement fee based on the input information, it is taught in Hunter. Hunter teaches providing application page containing an advertisement application form for receiving and storing information containing advertisement placement information (customer interface web server) (see col. 2 line 66 to col. 3 line 30), calculating fee based on the selection; sending specific information to the be displayed (server 100) (see col. 3 line 62 to col. 4 line 46). It would have been to one of ordinary skill in the art to provide application page for receiving and storing information containing advertisement placement information and calculated fee based on the input information. One would be motivated to provide advertisers a direct access for purchasing promotional displays and for directly sending their ads electronically, to be displayed at the locations and time selected by the advertiser as taught by Hunter (see col. 1 lines 7-18 and col. 2 lines 1-25), and to calculate

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fee that would provide revenue. Hunter does not teach the calculating fee is with a second server, which is separate from the first server. It would have been obvious to one of ordinary skill in the art at the time of the invention to use separate server to calculate fees and to perform billing process if the accounting is performed by different office.

Regarding claim 17, Hunter teaches payment using debit payment or other suitable payment code (see col. 4 lines 44-47). Official notice is taken that is old and well known in credit card processing, to confirm credit card validity by a credit card company or banks. It would have been obvious to one of ordinary skill in the art at the time of the invention for someone to know that Hunter's payment system would confirm the validity of the credit card used for payment by contacting the credit card issuer, to avoid fraud.

Regarding claim 19, Sleeper does not teach confirming a POS system specified by the input information and sending the information to the confirmed POS system, it is taught in Hunter (see col. 1 line 66 to col. 2 line 25 and col. 2 line 66 to col. 3 line 21 and col. 4 lines 9-44). Hunter teaches specifying which locations (site code specified for the location) receive the message and transmitting the message to the locations selected by conforming the site code of the display location. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Hunter's selection of specific location, in Sleeper's retail system in order to provide advertisers of Sleeper an option to selectively display or print their advertisement in specific retail stores.

Claims 22 and 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,430,603) and further in view of Sleeper (US 6,401,074).

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Regarding claims 22 and 23, Hunter teaches sending an application page containing an advertising placement application form with a first server (see fig. 1, customer interface web server and col. 2 line 66 to col. 3 line 30), receiving and storing the input information; calculating an advertising fee based on the input information with a second server (see col. 3 lines 21-30); sending payment specification form to the client PC (col. 4 lines 4-42); confirming fee payment (see col. 4 lines 43-46) and registering in POS system (Point of service) advertising information with a central computer (servers) and outputting advertisement (displays). Hunter does not teach outputting the advertisement by means of the printing device (printing the advertisement on a receipt or ticket). Sleeper teaches outputting advertisement provided by vendors and manufacturers by means of printer device. It would have been obvious to one of ordinary skill in the art at the time of the invention to output the advertisement of Hunter in Sleeper's POS's printing devices for the purpose of providing promotional information to customer at the point of sale, as taught by Sleeper (see abstract, col. 3 lines 1-67 and col. 9 line 60 to col. 10 line 12)

### ***Response to Arguments***

Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive.

Applicant argues that both Sleeper and Hunter do not disclose or suggest means for distributing specific data in the input information to the subscriber POS system. Examiner would like to point out that Hunter teaches means for distributing specific data in the input information to registered billboards from which a customer can select, to display his/her advertisement messages. Hunter teaches an application page for entering customer information (ABC Cola



corp.), an advertisement information (ocean scene with graphics, content code 1111, or mountain scene with graphics, content code 2222) for entering information specifying distribution area (advertisement area, Atlanta, Georgia, Interstate 75 N, milepost 125, one site (XXX) or 100 sites, (YY... ZZZ), advertisement period, (Time: 7:30 AM, June 30, 2000), demographic, etc.. (see col. 4).

Applicant's specification also teaches the same application page, including the distribution area designated by indicating store names or area names, for example specific states, prefectures, countries, districts, cites, towns, villages or streets. An entry section of a selection box containing a list of the selectable store names or regions (same as Hunter). specifying the advertisement period, information specifying the advertisement target (see applicant's specification page 14 and 15 and fig. 10). The only difference between Hunter and applicant's invention is that the advertisement are printed on transaction receipts, instead of displaying it on billboards. Examiner relied on Sleeper for the teaching of specifying advertisement to be printed on cash register receipts. Therefore in combination Sleeper and Hunter teach the applicant's claimed invention. Applicant argues that Sleeper is silent regarding the retailer or POS system subscribing to receive the advertisement information. Examiner agrees with applicant. As indicated in the previous office action, Sleeper teaches displaying, and printing on the receipt, promotional information about manufacturer's product and generating revenue by selling advertisement space to advertisers (see col. 9 line 42 to col. 10 line 12). Sleeper however does not explicitly teach how the advertisers or manufacturers submit the advertisement to be displayed at the POS system of the retail stores. Hunter provides the application page for advertisers to specify where and when to display their advertisement message. Thus, in response

to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER